

REMARKS

Status of the claims:

Claims 1-20, 22-23, 25-35, and 37-42 are pending and ready for further action on the merits. Reconsideration is respectfully requested in light of the following remarks.

Rejections under 35 U.S.C. § 103

Claims 1, 3, 4, 6, 7, 10-16, 19, and 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Brewer '760 (US Patent No. 197,760) in view of Keaveney '018 (US Patent No. 5,938,018) and Funderburk '006 (US Patent No. 6,726,006).

Claims 2, 22, 23, 25-27, 30, 33-35, 37 and 38 are rejected under 35 U.S.C. §103(a) as being unpatentable over Brewer '760 in view of Keaveney '018 and Funderburk '006 and further in view of Clemens '623 (US Patent No. 3,007,623).

Claim 5 is rejected under 35 U.S.C. §103(a) as being unpatentable over Brewer '760 in view of Keaveney '018 and Funderburk '006 and further in view of Moore '604 (US Patent No. 2,185,604).

Claims 8, 9, 39 and 40 are rejected under 35 U.S.C. §103(a) as being unpatentable over Brewer '760 in view of Keaveney '018 and Funderburk '006 and further in view of Fletcher '365 (US Patent No. 3,062,365).

Claims 17, 18, 41, and 42 are rejected under 35 U.S.C. §103(a) as being unpatentable over Brewer '760 in view of Keaveney '018 and Funderburk '006 and further in view of Fletcher '365 and Moore '604.

Claims 28 and 29 are rejected under 35 U.S.C. §103(a) as being unpatentable over Brewer '760 in view of Keaveney '018 and Funderburk '006 and further in view of Clemens '623 and Fletcher '365.

Claims 31 and 32 are rejected under 35 U.S.C. §103(a) as being unpatentable over Brewer '760 in view of Keaveney '018 and Funderburk '006 and further in view of Clemens '623 and Moore '604.

Applicants traverse.

Removal of All 35 U.S.C. § 103 Rejections

Applicants submit that the Examiner has failed to make a proper *prima facie* case of obviousness.

To establish a proper *prima facie* case of obviousness, three basic criteria must be met.

- 1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.
- 2) There must be a reasonable expectation of success.
- 3) The prior art reference (or references when combined) must teach or suggest all the claim limitations.

See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) and MPEP 2142.

Applicants submit that the Examiner has failed to show any of these criteria. For example, the Examiner has failed to show criteria 3) that the prior art reference (or references when combined) teach or suggest all the claim limitations.

None of the cited references against claim 1 disclose or remotely suggest “a plurality of cigarettes in the first and second compartments” as claimed in claim 1. Moreover, none of the references cited against claim 22 disclose or remotely suggest “a plurality of cigarettes of a first brand or type disposed in the first compartment; a plurality of cigarettes of a second brand or type, different from the first brand or type, disposed in the second compartment” as claimed in claim 22. Further, none of the references cited against claim 35 disclose or remotely suggest “inserting a first plurality of cigarettes into the first compartment” and “inserting a second plurality of cigarettes into the second compartment” with “the first compartment having a first opening defined by a first edge of the container body, the second compartment having a second opening defined by a second edge of the container body” as claimed in claim 35.

Removal of Rejection Using Brewer ‘760, Keaveney ‘018, and Funderburk ‘006

Brewer ‘760 discloses a box which has a rim A, hinged lids B and C that open on opposite sides, catches G and G, and a longitudinal partition D, which forms the compartments E and E. Brewer ‘760 discloses that the object of the invention is to provide a box for carrying tobacco and matches with the larger compartment E for tobacco and the smaller compartment E for matches. Nowhere does Brewer ‘760 disclose or remotely suggest a plurality of cigarettes in both compartments. As a matter of fact, Brewer ‘760 fails to disclose cigarettes at all (but rather only tobacco). It is noted that the publication date of Brewer ‘760 (May 21, 1877) is prior to the time that machine manufactured cigarettes were readily available. Thus, at the time Brewer ‘760 issued, putting cigarettes in containers was not even contemplated.

The Examiner has stated “Brewer-Keaveney merely lacks the sealing layer with the compartments sealed at a pressure less than atmospheric”. Applicants respectfully disagree. Neither Brewer ‘760 nor Keaveney ‘018 disclose or remotely suggest placing a plurality of cigarettes in a first compartment having a first opening defined by a first edge of the container body, and in a second compartment having a second opening defined by a second edge of the container body. As was discussed above, Brewer ‘760 fails to even disclose cigarettes and at no place discloses even placing tobacco in both compartments of the tobacco box of Brewer ‘760. Because Keaveney ‘018 does not even disclose a two compartment container, it is impossible for Keaveney ‘018 to disclose placing a plurality of cigarettes in two compartments.

Funderburk ‘006 fails to make up for the deficiencies of Brewer ‘760 and Keaveney ‘018. Funderburk ‘006 fails to disclose or remotely suggest placing a plurality of cigarettes in a first compartment having a first opening defined by a first edge of the container body, and in a second compartment having a second opening defined by a second edge of the container body. Accordingly, claim 1 can not be rendered obvious by the combination of Brewer ‘760, Keaveney ‘018 and Funderburk ‘006. The rejection of claim 1 and claims dependent from 1 (*i.e.*, claims 3, 4, 6, 7, 10-16, 19, and 20) over Brewer ‘760, Keaveney ‘018 and Funderburk ‘006 is inapposite. Withdrawal of the rejection over these claims is warranted and respectfully requested.

Removal of the Rejection Using Brewer ‘760, Keaveney ‘018, Funderburk ‘006 and Clemens ‘623

Clemens ‘623 fails to make up for the deficiencies of Brewer ‘760, Keaveney ‘018 and Funderburk ‘006. Clemens ‘623 also fails to disclose or remotely suggest

placing a plurality of cigarettes in a first compartment having a first opening defined by a first edge of the container body, and in a second compartment having a second opening defined by a second edge of the container body as claimed in claim 1 or “a plurality of cigarettes of a first brand or type disposed in the first compartment; a plurality of cigarettes of a second brand or type, different from the first brand or type, disposed in the second compartment” with “each compartment having a perimetrical edge defining first and second openings on opposite sides of the container body” as claimed in claim 22, or “inserting a first plurality of cigarettes into the first compartment” and “inserting a second plurality of cigarettes into the second compartment” with “the first compartment having a first opening defined by a first edge of the container body, the second compartment having a second opening defined by a second edge of the container body” as claimed in claim 35.

Thus, the combination of Brewer ‘760, Keaveney ‘018, Funderburk ‘006, and Clemens ‘623 cannot render obvious the present invention as claimed in claims 2, 22, 23, 25-27, 30, 33-35, 37 and 38. The rejection is inapposite. Withdrawal of the rejection over these claims is warranted and respectfully requested.

Removal of the Rejection Using Brewer ‘760, Keaveney ‘018, Funderburk ‘006, and Moore ‘604

Moore ‘604 also fails to make up for the deficiencies of Brewer ‘760, Keaveney ‘018, and Funderburk ‘006. As do Brewer ‘760, Keaveney ‘018, and Funderburk ‘006, Moore ‘604 also fails to disclose placing a plurality of cigarettes in a first compartment having a first opening defined by a first edge of the container body, and in a second compartment having a second opening defined by a second edge of the container body.

Accordingly, claim 5 cannot be rendered obvious by the combination of Brewer '760, Keaveney '018, Funderburk '006, and Moore '604. Withdrawal of the rejection is warranted and respectfully requested.

Removal of the Rejection Using Brewer '760, Keaveney '018, Funderburk '006, and Fletcher '365

Fletcher '365 also fails to make up for the deficiencies of Brewer '760, Keaveney '018 and Funderburk '006. Fletcher '365 discloses a neat attractive case or container for cigarettes with individual compartments for each cigarette (see column 1, lines 33-35 in Fletcher '365). The reason why Fletcher '365 discloses a compartment for each cigarette is so that a person who is trying to reduce the amount they smoke can easily monitor the number of cigarettes they have smoked. It should be apparent to those of ordinary skill in the art that having an individual cigarette in each compartment does not satisfy the feature of placing a plurality of cigarettes in a first compartment having a first opening defined by a first edge of the container body, and in a second compartment having a second opening defined by a second edge of the container body. One cigarette is not a plurality of cigarettes. Accordingly, Fletcher '365 combined with Brewer '760, Keaveney '018 and Funderburk '006 cannot render obvious the claims dependent from claim 1 of the instant invention. Regarding independent claim 39 and claims dependent therefrom, none of Fletcher '365, Brewer '760, Keaveney '018 or Funderburk '006 disclose "first and second sealing layers removably affixed to the first and second edges of the container body for sealing the articles in the first and second compartments" as claimed in claim 39. Accordingly, a proper *prima facie* case of obvious over the combination of Fletcher '365, Brewer '760, Keaveney '018 and Funderburk '006 has not

been presented. Withdrawal of the rejection over claims 8, 9, 39 and 40 using the combination of Fletcher '365, Brewer '760, Keaveney '018 and Funderburk '006 is warranted and respectfully requested.

Removal of the Rejection Using Brewer '760, Keaveney '018, Funderburk '006, Moore '604, and Fletcher '365

Finally, the combination of all of Moore '604, Fletcher '365, Brewer '760, Keaveney '018 and Funderburk '006 cannot render obvious claims 17, 18, 41, and 42 because none of the references disclose placing a plurality of cigarettes in a first compartment having a first opening defined by a first edge of the container body, and in a second compartment having a second opening defined by a second edge of the container body as claimed in claim 1 (and therefore present in claims 17 and 18). Moreover, none of the references disclose a "first and second sealing layers removably affixed to the first and second edges of the container body for sealing the articles in the first and second compartments" as claimed in claim 39 (and therefore present in claims 41 and 42). Accordingly, withdrawal of the rejection over claims 17, 18, 41, and 42 using the combination of Moore '604, Fletcher '365, Brewer '760, Keaveney '018 and Funderburk '006 is warranted and respectfully requested.

Further, Applicants submit that even if a proper *prima facie* case of obviousness had been presented over any of the above mentioned references (which Applicants do not concede), the Examiner is using improper hindsight reconstruction to arrive at the instant invention. It is recognized that to present a proper *prima facie* obviousness rejection, some degree of reconstruction based on hindsight reasoning is required. However, in the instant case, the Examiner has employed impermissible hindsight reasoning.

The Examiner has picked features from the cited patents that ignore other teachings in the patents. As an example, an object of the invention of Brewer '760 is to have matches and tobacco together in one carrying case but in different compartments. Brewer '760 specifically mentions that one compartment is smaller than the other to accommodate matches. It is unclear that this smaller compartment would be able to accommodate cigarettes, and if it were of a size so that one could and does place a plurality of cigarettes in the compartment, what would happen to the matches? In other words, an object of the invention of Brewer '760 would be destroyed.

As another example, Fletcher '365 discloses a neat attractive case or container for cigarettes with individual compartments for each cigarette (see column 1, lines 33-35 in Fletcher '365) so that one can properly keep track of the number of cigarettes smoked. If one were to place a plurality of cigarettes in each compartment (as claimed in the instant claim 1), one would not be able to easily tell the number of cigarettes that had been smoked, thereby destroying an object of the Fletcher '365 patent. It is well settled that if a "proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Moreover, if one were to have only one cigarette in each compartment as disclosed in Fletcher '365, one would not satisfy the elements of the instantly claimed invention. Thus, it should be apparent to those of ordinary skill that the rejections as presented are inapposite. Withdrawal of all rejections is warranted and respectfully requested.

CONCLUSION

With the above amendments and remarks, Applicants believe that all objections and/or rejections have been obviated. Thus, each of the claims remaining in the application is in condition for immediate allowance. A passage of the instant invention to allowance is earnestly solicited.

Applicants respectfully petition for a one month extension of time. Applicants believe that no fee is necessary, however, should a fee be deemed to be necessary, the Commissioner is hereby authorized to charge any fees required by this action or any future action to Deposit Account No. 16-1435.

Should the Examiner have any questions relating to the instant application, the Examiner is invited to telephone the undersigned at (336) 607-7486 to discuss any issues.

Respectfully submitted,

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